

REMARKS/ARGUMENTS

Status of Claims

Claims 3, 4, 22, 23 and 25 have been amended.

Claims 36-52 were previously canceled.

Claims 4-10 have been withdrawn.

Claim 53 is new.

Thus, claims 1-3, 11-35 and 53 are currently pending in this application.

Applicants hereby request further examination and reconsideration of the presently claimed application.

Restriction Requirement

Applicants acknowledge that the Office Action maintains that the restriction requirement was proper and therefore made final. However, Applicants direct the Examiner's attention to claims 4-8 which were withdrawn from consideration. Applicants submit that claims 4-8 should be afforded examination with the currently pending claims as these claims further define and limit the elected species of claim 1. Consequently, Applicants request the rejoinder of claims 4-8 for consideration with the pending claims.

Applicants concur with the Office Action's withdrawal of claims 9 and 10 from consideration.

Claim Rejections – 35 U.S.C. § 112

Claims 1-3 and 11-35 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In an effort to advance prosecution, Applicants have amended claim 3. The Office Action opines:

The stoichiometry of the solvate or hydrate and nature of the solvate used have not been described to such a [sic] extent to support the full genus of hydrates or solvates beyond the specific hydrate explicitly named, such as alendronate sodium trihydrate.

See Office Action at 4. Contrary to the assertions of the Office Action, Applicants submit that the Application provides sufficient written description for the genera of salts and hydrates. As noted by the Federal Circuit, “[w]hen a reference discloses a class of compounds, i.e., a genus, a person of ordinary skill in the art should be able to ‘at once envisage each member of the... class’ for the individual compounds, i.e., species, to be enabled” *Impax Laboratories Inc. v. Aventis Pharmaceuticals Inc.*, 81 USPQ2d 1001, 1013 (Fed. Cir. 2006) (quoting *In re Petering*, 301 F.2d 676, 681, 133 USPQ 275 (C.C.P.A. 1962)). Thus, it is not necessary to explicitly list each and every compound in that one of skill in the art would be able to “at once envisage” the members of these classes. As such, the written description is sufficient.

Applicants wish to note that the amendments to claim 3 should not be construed as admitting of the accuracy or correctness of the Office Action’s rejections but rather are submitted for the purposes of efficiency and advancing prosecution. Accordingly, Applicants preserve the right to assert the full range of equivalents to the claimed invention.

Claims 34 and 35 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Of claim 34, the Office Action states “the term ‘substantially free’ is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.” See Office Action at 5. Similarly, of claim 35, the Office Action states “the term ‘intimately’ is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably

apprised of the scope of the invention.” See Office Action at 5. A brief search of the claims of issued patents using the USPTO’s online database revealed 21,066 reciting the phrase “substantially free” and 811 patents reciting the phrase “intimately mixing.” As evidenced by the issuance of these patents by the United States Patent and Trademark Office, the phrases “substantially free” and “intimately mixing” are widely accepted by the USPTO. As such, Applicants respectfully request that these rejections be withdrawn.

Claim Rejections – 35 U.S.C. § 102

Claims 1-3, 11-22, 25-32, and 34 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Jasprova, WO 02/03963 (hereinafter *Jasprova*). Claims 2-3, 11-13, and 25-35 depend from independent claim 1, and claims 15-24 depend from independent claim 14. Thus, claims 2-3, 11-22, 25-32 and 34 stand or fall on the application of *Jasprova* to independent claims 1 and 14. According to MPEP § 2131, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Applicants submit that *Jasprova* fails to teach “each and every” element of independent claims 1 and 14.

Specifically, Applicants submit that *Jasprova* fails to teach an oral formulation which includes an intragranular phase. Independent claims 1 and 14 read:

1. An oral formulation **which includes an intragranular phase** comprising a bisphosphonic acid derivative and at least one carbohydrate alcohol, **together with an aqueous binder.**

14. An oral formulation **which includes an intragranular phase** comprising a bisphosphonic acid derivative and a carbohydrate alcohol which is mannitol, **together with an aqueous binder.**

See *supra* (Emphasis added). As shown above, each of independent claims 1 and 14 recites ***an oral formulation which includes an intragranular phase.*** To the contrary, *Jasprova* teaches:

As is documented below in the Examples, the combination of diluents according to the invention with exclusion of lactose makes it possible to obtain acceptable properties of the tablets in an economic compressing process, regardless of sensitive substances, which is **free of any granulation or pre-granulation of the components**.

See *Jasprova* at 9. Thus, *Jasprova* does not teach a granulation step; as such, *Jasprova* cannot teach an oral formulation which includes an intragranular phase.

Also shown above, each of claims 1 and 14 recite ***an aqueous binder***. To the contrary, *Jasprova* teaches forming the pharmaceutical composition via compression utilizing a dry binder:

A pharmaceutical formulation produced by direct compression usually includes a dry binder

See *Jasprova* at 9. See also *Jasprova* at 10-12. Thus, *Jasprova* does not teach an aqueous binder. For the reasons given here and above, *Jasprova* fails to teach each and every element of independent claims 1 and 14 and, as such, cannot anticipate claims 1-3, 11-22, 25-32, and 34.

Claim Rejections – 35 U.S.C. § 103

Claims 1-3 and 11-34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Jasprova* in view of Flash-Ner-Barak, et al., WO 02/00204 (hereinafter *Flash-Ner-Barak*). Alternatively, claims 1-3 and 11-35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Jasprova* and *Flash-Ner-Barak* as applied to claims 1-3 and 11-34 and further in view of Katdare, et al., WO 95/29679 (hereinafter *Katdare*). Claims 2-3, 11-13, and 25-35 depend from independent claim 1 and claims 15-24 depend from independent claim 14. Thus, claims 2-3 and 11-35 stand or fall on the application of *Jasprova* and *Flash-Ner-Barak*, alternatively, *Jasprova*, *Flash-Ner-Barak*, and *Katdare*, to independent claims 1 and 14. As noted by the United States Supreme Court in *Graham v. John Deere Co. of Kansas City*, an obviousness determination begins with a finding that **“the prior art as a whole in one form or another contains all” of the elements of**

the claimed invention. See *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 22 (U.S. 1966). The Applicants respectfully submit that the combination of *Jasprova* and *Flash-Ner-Barak*, alternatively, the combination of *Jasprova*, *Flash-Ner-Barak*, and *Katdare*, fails to contain all of the elements of the pending claims.

Specifically, Applicants submit that the combination of *Jasprova* and *Flash-Ner-Barak*, alternatively, the combination of *Jasprova*, *Flash-Ner-Barak*, and *Katdare*, does not contain an aqueous binder. As shown above, each of claims 1 and 14 recite ***an aqueous binder***. Also shown above, *Jasprova* does not teach an aqueous binder.

With regards to *Flash-Ner-Barak*, the reference discloses:

One object of the invention is to provide a dosage form such as a tablet that is retained in the stomach for an extended period of time **by swelling to a size that prevents passage through the pylorus upon contact with gastric juices.**

The inventive composition also **includes a superdisintegrant.** Superdisintegrants are pharmaceutical excipients within a larger class of excipients known as disintegrants. . . . **Superdisintegrants are disintegrants that swell upon contact with water.**

See *Flash-Ner-Barak* page 8 lines 4-9 and page 6 lines 17-20. Thus, the reference teaches the use of superdisintegrants that swell upon contact with water. One of ordinary skill in the art would readily understand that the superdisintegrant of *Flash-Ner-Barak* when contacted with the Applicants' aqueous binder would absorb the water of the aqueous binder. Consequently, the Applicants' aqueous binder would result in swelling of the tablet upon contact with the superdisintegrant during manufacture and the resulting product would fail to provide upon ingestion a "tablet that is retained in the stomach for an extended period of time by swelling to a size that prevents passage through the pylorus upon contact with gastric juices." Therefore, *Flash-Ner-Barak cannot teach an aqueous binder*. Thus, *Flash-Ner-Barak* cannot remedy the shortcomings of *Jasprova*.

With regard to *Katdare* the reference discloses:

The present invention is directed in a first embodiment to a process for the preparation of pharmaceutical compositions of bisphosphonic acids by wet granulation formulation. This process employs a blend of a bisphosphonic acid and minimal amounts of other processing aids **with no binder added.**

See *Katdare* page 2 lines 10-15. Thus, *Katdare* teaches that a binder is not necessary in a composition comprising bisphosphonic acid and, as such, ***cannot be cited as teaching an aqueous binder.***

For the forgoing reasons, the combination of *Jasprova* and *Flash-Ner-Barak*, alternatively, the combination of *Jasprova*, *Flash-Ner-Barak*, and *Katdare*, fails to contain any teaching of an aqueous binder and, as such, cannot render obvious the pending claims.

New Claims

New claim 53 recites novel and nonobvious aspects of the Applicants' claimed subject matter. Support for claim 53 can be found in paragraph [0002] of the instant application. Claim 53 depends from claim 1 and is likewise allowable over the cited references for the reasons set forth previously herein.

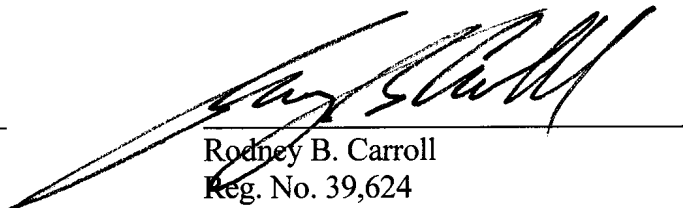
CONCLUSION

Consideration of the foregoing amendments and remarks, reconsideration of the application, and withdrawal of the rejections are respectfully requested by Applicants. No new matter is introduced by way of the amendment. It is believed that each ground of rejection raised in the Office Action dated September 24, 2008 has been fully addressed. If any fee is due as a result of the filing of this paper, please appropriately charge such fee to Deposit Account Number 50-1515 of Conley Rose, P.C., Texas. If a petition for extension of time is necessary in order for this paper to be deemed timely filed, please consider this a petition therefore.

If a telephone conference would facilitate the resolution of any issue or expedite the prosecution of the application, the Examiner is invited to telephone the undersigned at the telephone number given below.

Respectfully submitted,
CONLEY ROSE, P.C.

Date: 3-24-09



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